

REMARKS

I. Introduction

The Office Action rejected claims 13-16 under 35 U.S.C. 112, second paragraph; rejected claims 5-8 and 11-12 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 4,524,975 (Caughie); rejected claims 1-4 and 17-20 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,639,091 (Morales) in view of U.S. Patent 3,314,168 (Heckman); rejected claims 9-10 under 35 U.S.C. 103(a) as being unpatentable over Caughie in view of Heckman; and rejected claims 13-16 under 35 U.S.C. 103(a) as being unpatentable over Heckman in view of Caughie.

The present response corrects a spelling error on page 18, last paragraph, of the specification; cancels claims 4, 13-16, and 20; amends claim 1; and adds new claims 21-32.

Reconsideration and allowance of the amended application is respectfully requested.

II. Originally Filed Application Supports Amendments and New Claims

Since the amendments and new claims are supported by the originally filed application, their entry is respectfully requested. In particular, support for the amended and new claims is present in the original application at, inter alia, the following locations:

<u>Claim</u>	<u>Basis in Original Application</u>
1	Page 6, line 19 through page 7, line 8.
21, 22, 28	Page 5, line 23 though page 6, line 12; Figures 1-2.
23, 29	Original claim 2; page 6, lines 18-19.
24, 30	Original claim 3; page 6, lines 18-19.
25-26	Page 7, line 10 through page 8, line 6; Figure 3.
27	Original claims 1 and 4; page 1, line 24 through page 2, line 7; page 5 line 23 through page 7, line 16; page 18, lines 22-23; Figures 1-2.
31-32	Original claim 17; page 7, line 10 through page 8, line 6; Figure 3.

In addition, the amendment to the last paragraph on page 18 of the specification corrects a spelling error by replacing the word "for" with the word "four".

Accordingly, because the originally filed application supports the amendments and new claims, their entry is respectfully requested.

III. Rejections of Claims 4, 13-16, and 20 Rendered Moot

The cancellation of claims 4, 13-16, and 20 renders their rejections moot.

IV. Caughie Does Not Anticipate Claims 5-8 and 11-12

Because Caughie fails to teach each and every element of any of claims 5-8, 11, or 12, Caughie does not anticipate any of these claims. In particular, as noted in MPEP §2131:

**TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH
EVERY ELEMENT OF THE CLAIM**

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." (Citation omitted; MPEP's emphasis.)

Accordingly, for Caughie to anticipate any of claims 5-8, 11, or 12, each and every element of the anticipated claim must be found, either expressly or inherently described, in Caughie. However, Caughie fails to anticipate any of claims 5-8, 11, or 12 because at least one element of each of these claims is not expressly or inherently described in Caughie.

More specifically, claim 5 is an independent claim and claims 6-8 and 11-12 depend, either directly or indirectly, from claim 5. Claim 5 requires, inter alia, the following claim elements:

<u>Claim Element</u>	<u>Description of Claim Element</u>
1	"at least a first numerical die having N_1 faces"
2	" N_1 is an integer at least equal to 10"
3	"each face of the first numerical die bears a different first integer within the range of -1 to $-N_1$ "

Accordingly, above claim elements 1-3 of claim 5 require that each face of a multi-faced numerical die display a different negative number. To illustrate, when N_1 equals 12, the first numerical die has 12 faces and each face bears a different negative number selected from the group consisting of -1, -2, -3, -4, -5, -6, -7, -8, -9, -10, -11, and -12. By arbitrarily assigning a number to each face of the die, the correlation between the different faces of the first numerical die and the different displayed negative numbers can be represented as follows:

Face:	<u>1</u>	<u>2</u>	<u>3</u>	<u>4</u>	<u>5</u>	<u>6</u>	<u>7</u>	<u>8</u>	<u>9</u>	<u>10</u>	<u>11</u>	<u>12</u>
Integer:	-1	-2	-3	-4	-5	-6	-7	-8	-9	-10	-11	-12

The above correlation is also shown in Figure 4 of Applicant's application.

Claim 5 is not anticipated because nowhere in Caughie is there an express or inherent disclosure of, inter alia, claim 5's claim elements 1-3 that require the presence of a different negative number on each face of a multi-faced numerical die. In particular, whenever Caughie illustrates his casting solids or dice in his figures or discusses them in his specification, at least some of the faces on the casting solids are shown or described, respectively, as bearing positive numbers, letters, and/or blank spaces. Accordingly, since the requirement of claim elements 1-3 of claim 5 that each face of a multi-faced numerical die must display a different negative number is not expressly or inherently described by Caughie, Caughie does not anticipate claim 5.

Furthermore, since claims 6-8 and 11-12 depend, directly or indirectly, from claim 5, claims 6-8 and 11-12 also contain all the claim elements present in claim 5 and are, therefore, also not anticipated by Caughie for the reasons discussed above with respect to claim 5. Accordingly, withdrawal of the 102(b) rejection of claims 5-8 and 11-12 is respectfully requested.

V. The Office Action Has Failed to Carry Its Burden With Respect To Claims

9-10 and 17-19

A. Introduction

The Office Action bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. See MPEP §2142. As quoted in MPEP §2142 from *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985):

"To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references."

For the reasons discussed in the following sections, the Office Action has failed to carry its burden with respect to claims 9-10 and 17-19.

B. The Office Action Has Failed to Carry Its Burden With Respect To Claims

9-10

As noted above in section I, the Office action rejected claims 9-10 under 35 U.S.C. 103(a) as being unpatentable over Caughie in view of Heckman. In support of the 103(a) rejection of claims 9-10, the Office Action (on page 7) alleged, in pertinent part, that:

Caughie further teaches integer values within the range of -1 to -N as well as within the range of 1 to N (see figures 1D-1F), regardless of the number of faces [on the dice].

Caughie fails to teach dice with mathematical operations thereof.

Heckman teaches the use of dice with mathematical operations thereon (see figure 2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include dice with mathematical operations thereon to the game of Caughie to facilitate simplification of cumulative movement during the game.

For the following reasons, the Office Action's above allegations do not support the 103(a) rejection of claim 9-10. First, as discussed in preceding section IV, Caughie does not teach the requirement of claim 5 that each face of a multi-faced numerical die must display a different negative number. Since claims 9-10 depend, either directly or indirectly, from claim 5, it follows that claims 9-10 also require that each face of a multi-faced numerical die must display a different negative number. Accordingly, for the reasons discussed above with respect to claim 5, Caughie does not teach or suggest the requirement of claims 9-10 that each face of a multi-faced numerical die must display a different negative number. Furthermore, the Office Action has not pointed to anything in Heckman that teaches or suggests the requirement of claims 9-10 that each face of a multi-faced numerical die must display a different negative number.

In addition, for the following reasons, the Office Action's allegation that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to include dice with mathematical operations thereon to the game of Caughie to facilitate simplification of cumulative movement during the game" is erroneous and unsupported by the references or any reasonable inferences capable of being extracted from them. In particular, Caughie does not teach any "cumulative movement during the game" that dice with mathematical operations thereon can be used to simplify. Furthermore, even if Caughie did teach "cumulative movement during game play" (which Caughie